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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,035

07/16/2007

Nobutaka Okabe

60626.00022

8784

32294

7590

08/20/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

PLUCINSKI, JAMISUE A

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/594,035	Applicant(s) OKABE ET AL.	
	Examiner JAMISUE A. PLUCINSKI	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haunschild (US 2004/0139053) in view of Chambers, Jr. et al. (US 2005/0027578).

4. With respect to Claims 3 and 4: Haunschild discloses the use of an apparatus and method for supporting the revision of a checklist for checking soundness of a company in accordance with the revision of laws and ordinances (see abstract) comprising:

a. A first database of laws/ordinances and provisions which includes the names of the provisions (See Figure 8 and data structure of Claim 41);

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- b. A computer for supporting the checking of laws and ordinances and compiling updated checklist (claim 41);
 - c. A means for connecting a computer to external databases (second database, which includes the government databases, which would include the text of the regulations) for retrieving updates laws and ordinances (See Paragraph 0051-0085 and 0087);
 - d. When receiving an update the tasks are updates and signals are sent to the departments notifying them of the updates (See Paragraphs 0017 and 0018).
5. Haunschild discloses the use of a web-based system which will generate a revised checklist (Figure 8), however fails to disclose the checklist being saved in a database, and when an update is received, updating the checklist by either modifying the task, deleting a task or adding a task to the checklist in the database. Chambers discloses the use of a first database which stores a checklist (See abstract) and when there is an update to the checklist the stored checklists are updated by modifying, deleting or adding tasks (See Paragraphs 0002, 0024 and 0032). Figure 8 of Hauschild shows a checklist which includes the names of the provisions, and by Chambers modifying this checklist, would modify the information that was already in the checklist of Hauschild, therefore the combination would teach the name of the provision as well as the information on the provision would be either deleted, added or updated. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to store the checklist in a database, and update the checklist when changes are necessary, as disclosed by Chambers and it would have been well within the ordinary skill in the art to update checklist to track changes and to have checklist automatically updated (See Chambers 2 and 3).

Response to Arguments

6. Applicant's arguments filed 5/6/08 have been fully considered but they are not persuasive.

7. With respect to Applicant's argument that Hauschild and Chambers fails to disclose a second database of the texts of the regulations: Hauschild as discloses above discloses the use of a data structure, which the examiner considers to be the first database, and discloses the use of a connection to a government regulation database, which the examiner considers to be a second database. The government regulation database, as stated by the applicant is the database which has the texts of the provisions and the data structure of first database is updated based off of this database. Therefore it is the examiner's position that Hauschild does in fact disclose the second database as claimed.

8. With respect to Applicant's argument that Hauschild and Chambers fails to disclose deleting, adding or updating the checklist with the name of the provision: The references are explained further above to disclose that due to the fact that the check list of Hauschild discloses the names of the provisions, in Figure 8, Chambers discloses the feature of storing the checklist and the revision steps of adding, deleting and updating a checklist. When Chambers is used, it would modify the checklist, which is created by Hauschild. Therefore the combination of Hauschild and Chambers would produce the feature of name of the provision being deleted, added or updated. The application states that the revision process of Hauschild has significant differences as compared to the revision process according to the embodiments of the invention. And the examiner considers Chambers to teach these differences. Hauschild discloses the use

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system updates the regulatory compliance data by comparing the existing rules and regulations with newly published compliance rules from a regulatory database, the examiner considers this to be determining whether a revision relates to the regulatory compliance data stored, due to the fact that in order to update the rules and regulations, which Hauschild does, then it must first relate. As stated above, the examiner considers the government regulatory database to be the “all-laws” database, and the data structure of claim 1 to be the regulations which apply to the company.

9. Arguments are not considered to be persuasive and rejection stands as stated above.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/
Examiner, Art Unit 3629